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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,954	09/03/2004	Alexander Shipp	117-512	1417

23117   7590   01/08/2008
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EXAMINER
RAYYAN, SUSAN F

ART UNIT	PAPER NUMBER
2167	

MAIL DATE	DELIVERY MODE
01/08/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/500,954	SHIPP, ALEXANDER
	Examiner	Art Unit	
	Susan F. Rayyan	2167	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>13 November 2007</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,5-8 and 11-16* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,5-8 and 11-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

November 13, 2007 has been entered.

DETAILED ACTION

2.   Claims 1-2, 5-8,11-16 are pending.

3.   Claims 3-4,9-10 have been canceled.

Claim Rejections - 35 USC § 101

4.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

Claims 1-2, 5-6 are rejected under 35 U.S.C. 101 because the claimed invention

is directed to non-statutory subject matter.

Claims 1-2, 5-6 are directed to software per se. Claims 1-2, 5-6 teach " a computer

database containing records of known executable programs which are deemed to be

not malware and criteria by which a file being processed can be determined to be an

instance of one of those programs...", "means for processing a file being transferred

between computers ..." and " a difference checker ...", and "means for signaling the

file ...". The claims do not provide hardware such as a processor.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**Claims 1-5, 7-11,13-15 are rejected under 35 U.S.C. 103(a) as being
unpatentable over US Patent Application Publication Number 2004/0088570
issued to Guy William Welch Roberts et al ("Roberts") and US Patent 7,107,618
issued to Bryson Gordon et al ("Gordon").**

As per claims 1,7 Roberts teaches:

a) a computer database containing records of known ... which are
deemed to be not malware and criteria by which a file being processed can be
determined to be an instance of one of those programs, the criteria including at least
one characteristic signature associated with each instance (see paragraph 34, lines 1-7
and paragraph 37 as storing a checksum associated with the internet address.);
b) means for processing a file being transferred between computers , the means

comprising : a file recognizer operative for determine whether the file being processed is

an instance of a known file being processed for the presence of said at least one

characteristic signature associated with the said instances (paragraph 36, lines 6-10,

paragraph 37, lines 1-3 and Figure 6, Ref. No. 42 and paragraph 37, lines 8-13,

compare checksum against new checksum);

a difference checker operative , in the case that the file recognizer determines the file

being processed to be an instance of a known program to check whether the file is an

unchanged version of that known program (paragraph 37, lines 8-14, checksum);

and c) means for signaling the file depending on the determination made by the

processing means , as being :

likely to be not malware if it is an unchanged version of a known file, likely to be

malware if it is a changed version of a known file, or of unknown status if it is not

determined as being an instance of a known file (paragraph 38, lines 1-12 and .

paragraph 32, lines1-3 and figure 4:28).

Robert does not explicitly teach executable programs". Gordon does tech this

limitation at column 4, lines 58-60 as e-mail includes executable files and column 8,

lines 15-20 as executable files and column 3, lines 10-18 as load scanned content on to

host website. It would have been obvious to a person of ordinary skill in the art at the

time the invention was made to modify Roberts with executable program to certify

content available for download is safe to open (column 4, lines 10-15).

Claim 7 is rejected based on the same rationale as independent claim 1.

As per claims 2, 8, same as claim arguments above and Roberts teaches:

d) means for processing a file being transferred between computers to determine

whether it is considered to be, or considered possibly to be, malware and wherein the

means d) is operative to subject a file to processing if the file signaled by the signaling

means c) as being of unknown status (paragraph 37, lines 1-6 and paragraph 38).

As per claims 5,11, same as claim arguments above and Roberts teaches:

wherein the difference checker is operative to generate a checksum for the entire file

under consideration or for at least one selected region thereof, and to compare the

checksum or checksums with those of entries in the database (paragraph 37, lines 8-

14).

Claim 13 is rejected based on the same rationale as independent claim 1.

Claim 14 is rejected based on the same rationale as claims above and Roberts teaches:

a file scanning subsystem for scanning files identified by the processor as being of

unknown status to determine whether the scanned files are malware (paragraph 38

lines 4-6, content has change (checksum does not match) so it is unknown if the

change is due to malware and it is rescanned).

Claim 15, same as claim arguments above and Roberts teaches:

wherein the records for files which are instances of programs determined by the file-scanning system not to be malware are added to the computer database(see paragraph 34, lines 1-7).

Claims 6,12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts and Gordon in view of US Patent Number 5,617,533 issued to Wu et al ("Wu").

As per claim 6, 12 Roberts teaches signaling means is operative to signal the file as malware ... or as unknown if it is (paragraph 38). Roberts and Gordon do not explicitly teach including an exception list handler for determining, in relation to a file which the processing means b) has determined is not a known file, whether that file has characteristics matching an entry in an exception list of files. Wu does teach these limitations at column 8, lines 7-17, column 12, lines 54-60 and column 13, lines 32-45. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references to determine whether the corresponding software conforms with package rules (column 7, lines 50-57).

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts and Gordon in view of US Patent Application 2004/0128355 issued to Chao et al ("Chao").

Claim 16, same as claim arguments above and Roberts and Gordon does not explicitly teach wherein the processor assigns a score to a file identified as likely to be malware. Chao does teach this limitation (paragraph 34, lines 3-10 and paragraph 25, lines 12-21 as virus classification score) to provide the user with a warning message that an executable has been deleted due to a virus. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Roberts and Gordon with wherein the processor assigns a score to a file identified as likely to be malware to provide the user with a warning message that an executable has been deleted due to a virus (paragraph 37, lines 13-21).

Response to Arguments

6.   Applicant's arguments filed November 13, 2007 have been fully considered.

Applicant's arguments with regard to the rejection of claims 1-2, 5-8,11-16 under

35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out

and distinctly claim the subject matter which applicant regards as the invention is

convincing. Examiner has withdrawn the rejection.

Applicant argue Roberts does not teach executable program. Gordon does teach

this at column 4, lines 58-60 as e-mail includes executable files and column 8, lines 15-

20 as executable files and column 3, lines 10-18 as load scanned content on to host

website. It would have been obvious to a person of ordinary skill in the art at the time

the invention was made to modify Roberts with executable program to certify content

available for download is safe to open (column 4, lines 10-15).

Applicant argue prior art of record does not teach checking the contents of the

file being processed is an instance of a known program by checking the contents of the

file being processed for the presence of said at least one characteristic signature

associated... and a difference *checker ...to check whether the file is an unchanged*

version. Examiner finds Roberts teaches a checksum of the Internet web pages that

are pre-emptively scanned and stores the URL and checksum (characteristic signature)

in the database (paragraph 37) for comparison of the file being processed. The file

being processed is compared to URL then   checksum. The checksum is the claimed

characteristic signature used to determine whether the file has changed.

Applicant argues Roberts does not teach signaling unknown status if not a known

file . Examiner finds Roberts teaches this at paragraph 32, lines1-3 and figure 4:28,

scan content retrieved for malware. The retrieved content is of unknown status before it

is scanned for malware.

Contact Information

10.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Susan Rayyan whose telephone number is (571) 272-

1675. The examiner can normally be reached M-F: 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone

number for the organization where this application or proceeding is assigned is

703-872-9306.

Information regarding the status of an application may be obtained from

the Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR

only. For more information about the PAIR system, see http://pair-

direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susan Rayyan

January 6, 2008

JOHN COTTINGHAM
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